

## **REMARKS**

### **Status of the Claims**

Upon entry of the amendment above, claims 1-4 and 6-35 will be pending, claims 1, 8, 13, 19, 21, and 34 being independent.

### **Summary of the Office Action**

Claims 1-3, 6-8, 11-14, and 21 are rejected under 35 USC §103(a), as being unpatentable over KOGERT et al. (U.S. Patent No. 3,570,149, hereinafter "KOGERT"), as set forth in Section 3, beginning on page 2 of the Office action.

Claims 4, 9, 10, 16-20, 24-26, 34, and 35 are rejected under 35 USC §103(a) as being unpatentable over KOGERT in view of LENTZ (FR 726 292), as set forth in Section 3, beginning on page 3 of the Office action.

Claims 14, 15, 22, and 23 are rejected under 35 USC §103(a) as being unpatentable over KOGERT in view of BURT (U.S. Patent No. 6,401,364), as set forth in Section 4, on page 4 of the Office action.

### **Withdrawal of Rejections Based Upon KOGERT (Solely or in Combination)**

#### **A. Preliminary Remarks**

This reply is the second amendment following the interview with the Examiner on October 16, 2003. Although Applicants had believed their prior amendment should have been sufficient to place the instant application in condition for allowance, upon a review of the Examiner's statements in the recent Office action, they believe they have addressed what appear to be the Examiner current concerns, as explained below. Accordingly, reconsideration and withdrawal of the rejections based upon KOGERT, solely or in combination, is kindly requested.

Further, if the Examiner were to be of the opinion that Applicants' argument below differs from that which the Examiner is represented in the claims above, Applicants kindly request that the Examiner contact Applicants' undersigned representative regarding an amendment that would place the instant application in condition for allowance.

**B. Brief Summary of the Invention and Claims**

As explained in paragraphs 0006-0010 of their specification, Applicants' invention provides for a good ventilation of the foot for certain sporting activities (using a mesh material, for example), while providing, at the same time, a certain resistance to wear, such as resistance to abrasion.

Therefore, according to particular embodiment(s), only portion(s) of the upper and, perhaps, portion(s) of the sole are coated with a liquid polymer. In this regard, independent claims 1, 8, 13, and 21 specify that *a polymer layer is, or has been applied to, less than the entirety of the upper of the article of footwear of the invention*. Further, by logical implication, independent claim 19 also provides for the polymer layer being applied to less than the entirety of the upper (*i.e.*, inasmuch as the polymer is applied to the upper "to create a polymer layer having an upper edge extending along a line varying in height along a length of said upper ....")

In addition, it is important, particularly for the claimed invention, that the polymer be a *liquid polymer*. As mentioned in paragraph 0017 of their specification, a solvent is used to liquify the polymer for the purpose of the application to which the invention is directed.

**C. Arguments in Response to Continued Rejections Based Upon KOGERT**

Initially, Applicants submit that the rejections should be withdrawn for reasons of record.

In addition, in view of the amendment above to each and every independent claims, which are believed to address what might be the Examiner's concern that has led to his repeated reliance upon the rejections of record, Applicants submit that the reasons for withdrawal of the rejections has been reinforced.

The Examiner's reliance upon KOGERT continues from his previous *two* Office actions and following an interview with the Examiner several months ago (October 16, 2003).

In Applicants' previous reply (and as explained during the interview with the Examiner) Applicants had maintained that KOGERT coats the *entire* shoe with polyurethane, whereas Applicants claim that *less than the entirety* of the upper of the shoe has a liquid polymer coating.

KOGERT very clearly discloses that *the entire shoe* is coated with polyurethane. Indeed, KOGERT says so in column 1, line 17 ("... the whole shoe is coated ..."; column 1, lines 57-58 ("... the whole shoe being coated with an cohesive polyurethane layer ..."); and in claim 1, lines 4-5 ("... the entire shoe being coated externally throughout with a cohesive polyurethane layer ...").

In spite of KOGERT's clear disclosure, Applicants note the Examiner's comments that begin on page 5 of the Office action. There, *again*, the refers to column 2, lines 7-11 of KOGERT, which states that a *porous* polyurethane can be applied "where necessary." Thus, it appears that the Examiner still maintains that this passage suggests that *less than the entirety of the upper of KOGERT's shoe can be coated*. On page 5, lines 8-10 of the Office action, the Examiner comments that "This meets applicant's limitation of 'applying at least one layer of the flexible or semi-rigid polymer in predetermined areas of the upper, said predetermined areas constituting less than an entirety of the upper.'"

The optional *porous* polyurethane used by KOGERT relates to the need to increase thermal insulation (which might be needed in certain areas of the shoe).

In spite of that passage relating to PU being used for thermal insulation, KOGERT's claim 1 states "the *entire* shoe being coated externally throughout with a cohesive polyurethane layer ...."

Certainly, if KOGERT were to have contemplated coating less than the entire shoe, Applicants submit that he would *not* have limited his invention to coating the *entire* shoe.

Nevertheless, in spite of the foregoing, and upon further consideration, Applicants have presented an additional amendment to each of the independent claims, above, which is believed to emphasize a difference between their invention and the disclosure of KOGERT.

First, Applicants direct attention to KOGERT's claim 2 which relates to the passage in column 2, lines 7-11, which the Examiner cites in his rejection. There (in KOGERT's claim 2) it is stated that "at least a part" of the polyurethane layer is porous.

In view of that difference between KOGERT's claim 2 and parent claim 1, Applicants have now assumed that the Examiner's latest concern relates to the theory that the *porous* polyurethane, if used in the shoe of KOGERT, coats less than the entirety of the shoe, *despite the fact that the entirety of the shoe is, nevertheless, coated with a combination of porous and non-porous polyurethane*.

Therefore, to obviate such a reading of KOGERT, which Applicants do not necessarily endorse as correct, Applicants have amended every one of their claims to specify that "less than the entirety of the upper has a polymer coating", or similar language.

That is, with reference to claim 1, *e.g.*, as it stood prior to the amendment above, Applicants suggest that the Examiner's position might have been that the coating of the entirety of the shoe is possible within the scope of Applicants' claims, but that part of such coating is different from the remainder of the coating. That is, perhaps the Examiner's position is that part of the coating of KOGERT's shoe can be porous (on less than the entire shoe), and the remaining part can be non-porous --- despite the fact that the combination of porous + non-porous coating *completely coats* KOGERT's shoe.

However, Applicants' amendment above removes such an interpretation as being relevant to their claimed invention.

Accordingly, in view of the foregoing as well as the arguments of record, reconsideration and withdrawal of the rejections are requested.

#### **SUMMARY AND CONCLUSION**


The grounds of rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

No fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were to be necessary to render this reply timely and/or complete, Applicants request an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) that, in such event, would render this reply timely and/or complete, and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
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